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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/315,734 | 05/20/1999 | RAMARATHNAM VENKATESAN | MS-43/I(1166 | 6879 |
| 22801 | 7590 | 12/02/2003 | EXAMINER | |
| LEE & HAYES PLLC 421 W RIVERSIDE AVENUE SUITE 500 SPOKANE, WA 99201 | | | LIPMAN, JACOB | |
| | | | ART UNIT | PAPER NUMBER |

2134

DATE MAILED: 12/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/315,734

Applicant(s)

VENKATESAN ET AL.

Examiner

Jacob Lipman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-191 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-191 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 13 -37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete. It is being read as "wherein the license specifies a decryption key.
4. Claim 17 recites the limitation "the encryption key" in the last line. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 5-10, 12-15, 38, 40-45, 47, 48, 79-81, 83-88, 90-93, 103, 105-110, 112, 113, 126-132, and 153-158 are rejected under 35 U.S.C. 102(b) as being anticipated by Moskowitz et al., US Patent number 5,745,569.

With regard to claims 1, 79, and 126, Moskowitz discloses a computer system capable of accessing and controlling a watermarked software object (column 1 lines 50-52), the system comprising a processor and a memory (column 9 lines 8-9), wherein the

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processor reads one of a plurality of watermarks (column 5 lines 44-45) embedded in the software (column 2 lines 1-3) so as to yield a predefined value (column 3 lines 13-18) and sets usage rights of the object in response to the value (column 2 lines 7-14).

With regard to claims 2 and 80, Moskowitz discloses the software object can be either passive or active (column 1 lines 5-11).

With regard to claims 3 and 81, Moskowitz discloses that the operating system can control the watermarks to set a protection state (column 7 lines 1-13).

With regard to claims 5, 6, 83 and 84, Moskowitz discloses the watermark key points to the location of a watermark (column 1 lines 53-56).

With regard to claims 7, 8, 85 and 86, Moskowitz discloses that all the watermarks can contain identification of the product (column 1 lines 45-48).

With regard to claims 9 and 87, Moskowitz discloses that if the watermarks license information differs from the actual information, the software is disabled (column 3 lines 23-37).

With regard to claims 10, 12, 88 and 90, Moskowitz discloses the license information can contain more than one parameter (column 1 lines 45-48).

With regard to claims 13, as best understood, 14, 91 and 92, Moskowitz discloses the license specifies a decryption key (column 3 lines 14-15).

With regard to claims 15 and 93, Moskowitz discloses the key can be of public-key technology (column 3 lines 2-7).

With regard to claim 38, 40-45, 47, 48, 103, 105-110, 112, 113, 127-132, and 153-158, Moskowitz discloses the object can be network distributed (column 2 lines 45-54).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4, 11, 16-37, 39, 46, 49-78, 82, 89, 94-102, 104, 111, 114-125, 133-152, and 159-191 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danieli, US Patent number 6,510,513, in view of Moskowitz.

With regard to claims 4, 39, 82, 104, 176, and 180, Moskowitz teaches the watermarking system as outlined above, but does not mention what is done in the event of the expiration of the key. Danieli discloses an encryption system, such as watermarked software (column 21 lines 20-25), in which when the key expires, a new key is downloaded from the server (column 17 lines 15-24). It would have been obvious to one of ordinary skill in the art to include Danieli's expired key update system in Moskowitz's watermarking system to increase security and control over distributed software.

With regard to claims 11, 16, 46, 89, 94-99, and 111, Moskowitz teaches the watermarking system as outlined above, but does not mention that the license is signed. Danieli discloses an encryption system, such as watermarked software (column 21 lines

20-25), in which the license is signed (column 16 lines 50-55). It would have been obvious to one of ordinary skill in the art to include Danieli's signed license to Moskowitz's watermarking system to increase security and prevent the pirating of licenses.

With regard to claims 22-30, 32-37, and 100-102, Moskowitz discloses the watermarking system as outlined above and distributing a watermarked object over a network, but does not mention encrypting the object during transmission. The examiner takes official notice that encrypting distributed files with symmetric and/or asymmetric keys is well known in the art, and it would have been obvious to one of ordinary skill in the art to encrypt the object for distribution to further deter pirating of the software.

With regard to claim 31, Moskowitz discloses the keys can be acquired with a payment scheme (column 1 lines 30-34).

With regard to claims 49-78, 114-125, 133-152, and 159-191, Moskowitz teaches the watermarking system as outlined above, but does not mention that the license is acquired from a server. Danieli discloses an encryption system, such as watermarked software (column 21 lines 20-25), in which the license is acquired from a server (column 2 lines 42-45) over a secure network (column 6 lines 58-61). It would have been obvious to one of ordinary skill in the art to include Danieli's securely distributed license to Moskowitz's watermarking system to increase availability and to make security updates possible.

9. Claims 4, 11, 16-37, 39, 46, 49-78, 82, 89, 94-102, 104, 111, 114-125, 133-152, and 159-191 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asay et al., US Patent number 5,903,882, in view of Moskowitz.

With regard to claims 4, 39, 82, 104, 176, and 180, Moskowitz teaches the watermarking system as outlined above, but does not mention what is done in the event of the expiration of the key. Asay discloses an encryption system (column 11 lines 38-42), in which when the key expires, a new key is downloaded from the server (column 27 lines 20-55). It would have been obvious to one of ordinary skill in the art to include Asay's expired key update system in Moskowitz's watermarking system to increase security and control over distributed software.

With regard to claims 11, 16, 46, 89, 94-99, and 111, Moskowitz teaches the watermarking system as outlined above, but does not mention that the license is signed. Asay discloses an encryption system (column 11 lines 38-42), in which the license is signed (column 5 lines 29-33). It would have been obvious to one of ordinary skill in the art to include Asay's signed license to Moskowitz's watermarking system to increase security and prevent the pirating of licenses.

With regard to claims 22-30, 32-37, and 100-102, Moskowitz discloses the watermarking system as outlined above and distributing a watermarked object over a network, but does not mention encrypting the object during transmission. The examiner takes official notice that encrypting distributed files with symmetric and/or asymmetric keys is well known in the art, and it would have been obvious to one of ordinary skill in the art to encrypt the object for distribution to further deter pirating of the software.

With regard to claim 31, Moskowitz discloses the keys can be acquired with a payment scheme (column 1 lines 30-34).

With regard to claims 49-78, 114-125, 133-152, and 159-191, Moskowitz teaches the watermarking system as outlined above, but does not mention that the license is acquired from a server. Asay discloses an encryption system (column 11 lines 38-42), in which the license is acquired from a server (column 4 lines 28-38) over a secure network (column 15 lines 3-12). It would have been obvious to one of ordinary skill in the art to include Asay's securely distributed license to Moskowitz's watermarking system to increase availability and to make security updates possible.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Lipman whose telephone number is 703-305-0716. The examiner can normally be reached on 7:30 - 5 M-Th, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on 703-308-4789. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

JL


GREGORY MORSE
SUPERVISORY PATENT EXAMINER
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